

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
TYLER DIVISION**

MACROSOLVE, INC., § CIVIL ACTION NO. 6:11-cv-287  
§  
v. § **CONSOLIDATED LEAD CASE**  
§  
ANTENNA SOFTWARE, INC. et al. §

**MACROSOLVE INC.'S UNOPPOSED MOTION FOR DISMISSAL WITH  
PREJUDICE OF ITS ACTION AGAINST NEWEGG INC. AND DISMISSAL  
WITHOUT PREJUDICE OF NEWEGG'S COUNTERCLAIMS FOR  
DECLARATORY JUDGMENT FOR LACK OF SUBJECT MATTER JURISDICTION**

Plaintiff MacroSolve, Inc. (“MacroSolve”) hereby moves pursuant to Rule 41(a)(2) for voluntary dismissal with prejudice of its Complaint for patent infringement against defendant Newegg, Inc. (“Newegg”), and pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure for an order dismissing without prejudice Newegg’s counterclaims for declaratory judgment of invalidity and non-infringement for lack of subject matter jurisdiction. Newegg does not oppose this motion.

In addition, MacroSolve unconditionally agrees not to sue Newegg for infringement as to any claim of the patent-in-suit based upon Newegg’s manufacture, importation, use, sale and/or offer for sale of the products currently or in the past manufactured and sold by Newegg, or systems currently or in the past used or offered by Newegg, including all mobile apps operated and mobile app functionalities offered, currently or in the past, by Newegg. Here, statements made by counsel for MacroSolve are binding statements that preclude MacroSolve from asserting infringement of the patent-in-suit against Newegg’s past and current products and systems. MacroSolve further agrees not to sell, transfer, or assign, or to license with the right to

sue, the patent-in-suit to any third party under common ownership or control with MacroSolve without binding such a third party to the covenants made by MacroSolve herein.

In light of MacroSolve's covenant not to sue with respect to the patent-in-suit as to current and past products and systems, Newegg has no reasonable apprehension that it will face liability for infringement as to these claims. The Court therefore does not have subject matter jurisdiction over these claims as Newegg cannot satisfy the first prong of the justiciability test.

*See Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1059 (Fed. Cir. 1995).

Without an actual case or controversy, the Court is divested of jurisdiction. *Id.*

In light of MacroSolve's covenant not to sue Newegg and its voluntary dismissal of its claims for relief, MacroSolve's unopposed motion to dismiss the action against Newegg with prejudice and Newegg's counterclaims without prejudice for lack of subject matter jurisdiction should be granted.

Respectfully Submitted,

Dated: March 12, 2014

/s/ Califf T. Cooper  
Matthew J. Antonelli (lead counsel)  
Texas Bar No. 24068432  
matt@ahtlawfirm.com  
Zachariah S. Harrington  
Texas Bar No. 24057886  
zac@ahtlawfirm.com  
Larry D. Thompson, Jr.  
Texas Bar No. 24051428  
larry@ahtlawfirm.com  
Califf T. Cooper  
Texas Bar No. 24055345  
califf@ahtlawfirm.com  
ANTONELLI, HARRINGTON &  
THOMPSON LLP  
4200 Montrose Blvd, Suite 430

Houston, TX 77006  
(713) 581-3000  
(713) 581-3020 fax

S. Calvin Capshaw  
State Bar No. 03783900  
Email: [ccapshaw@capshawlaw.com](mailto:ccapshaw@capshawlaw.com)  
Elizabeth L. DeRieux  
State Bar No. 05770585  
Email: [ederieux@capshawlaw.com](mailto:ederieux@capshawlaw.com)  
D. Jeffrey Rambin  
State Bar No. 00791478  
Email: [jrambin@capshawlaw.com](mailto:jrambin@capshawlaw.com)  
CAPSHAW DeRIEUX, LLP  
114 E. Commerce Ave.  
Gladewater, Texas 75647  
Telephone: 903-236-9800  
Facsimile: 903-236-8787

*Attorneys for MacroSolve, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that on the 12th day of March, 2014, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Califf T. Cooper  
Califf T. Cooper

**CERTIFICATE OF CONFERENCE**

I hereby certify that I have complied with Local Rule CV-7. Specifically, I have conferred with counsel for defendants who has confirmed that the requested relief is unopposed.

/s/ Califf T. Cooper  
Califf T. Cooper